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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/041,129
Filing Date: July 23, 2003
Appellant(s): RAMESH ET AL.

MAILED
SEP 22 2005
Group 3700

Rupert B. Hurley, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 June 2005 appealing from the Office action mailed 25 October 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. patent application serial number 09/843,990 is a related application for which an Examiner's Answer has been mailed. The subject matter of the application may have a bearing on the Board's decision in this pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

the 37 CFR 1.75(c) objection of claims 45 and 46; and

the 35 USC 112, 2nd paragraph rejection of claims 44-46.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,837,358

Bauer et al.

11-1998

Admitted Prior Art (page 2, lines 5-15 of the application)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over appellant's admitted prior art (**AAPA**) in view of Bauer et al. (**US 5,837,358**).

AAPA (see page 2, lines 5-15 of appellant's specification) teaches that the method of placing a first product in a flexible bag formed from heat-shrinkable film, placing a second product in a flexible bag formed from heat-shrinkable film, stacking one bag on top of the other, and heat-sealing the first bag and second bag is old and well known in the prior art. AAPA meets all of the claimed subject matter with the exception of the composition of the bag, that is, the particular layers of the bag.

The Bauer et al. reference discloses a bag (see col. 15, lines 44-50 and col. 16, lines 52-54) used in a similar process (see col. 1, lines 10-20, col. 4, lines 4, lines 22-25, and col. 15, lines 44-50) which meets the claimed structure of the bag, that is, a first layer of polyolefin (col. 13, lines 22-24) which is the inside layer (14), a second layer of polyolefin (col. 14, lines 9-11) which is the interior layer (17), a third layer of polyester (col. 14, lines 25-29) which is the interior layer (18), and a fourth layer of polyester (col. 13, lines 38-40) which is the outside layer (15) -- as seen in figure 2.

It would have been obvious to a person having ordinary skill in the art, at the time appellant's invention was made, to have modified the method set forth in AAPA by having substituted the bag structure disclosed in Bauer et al. for the bag disclosed in AAPA, because the substitution of one old and well known bag structure for another old and well known bag structure is routine in the art, where as here there is presently no evidence that would reasonable convey that some result would be achieved by modification of the old and well known method set forth in AAPA that would be unexpected or contradict the expected result of AAPA. The structure of the bag does not effect the modified method in a manipulative sense.

Regarding the polyester of the third layer having a melting point of from about 130°C to about 260°C in claim 22, and the other composition limitations in the claims, the now modified AAPA does not disclose these limitations. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have employed a polyester as the third layer having a melting point of from about 130°C to about 260°C, since it has been held that discovering an optimum value of a

result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Also, the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claim 44, the Bauer et al. reference teaches the use of polyester (col. 13, line 24) as a first layer, and as set forth above the subject matter of the claim is likewise considered unpatentable.

Regarding claim 45, the Bauer et al. reference teaches the use of ethylene/alpha-olefin copolymer (col. 13, lines 29 and 30) as a first layer, and as set forth above the subject matter of the claim is likewise considered unpatentable.

Regarding claim 46, the Bauer et al. reference teaches the use of homogeneous ethylene/alpha-olefin copolymer (col. 7, line 49)

Note that for both claims 44-46, the language of the claim includes the quasi-open terminology "consists essentially of ..." and thus these claims do not exclude other non-recited polymers, etc.

(10) Response to Argument

Appellant's arguments filed 30 June 2005 with regard to the objections under 37 CFR 1.75(c) and rejections under 35 USC 112, 2nd paragraph have been reviewed and

are deemed persuasive. Accordingly, the objections under 37 CFR 1.75(c) and rejections under 35 USC 112, 2nd paragraph have been withdrawn.

Appellant first argues that the Nishimoto et al. reference, but it is pointed out that the examiner is relying on Appellant's admissions at page 2, lines 5-15, and not on the Nishimoto et al. reference. It is not clear to the examiner as to why the appellant is discussing the Nishimoto et al. reference, when the Nishimoto et al. reference does not form the basis for the rejection. Accordingly, the examiner does not believe it is necessary to respond to appellant's arguments regarding the Nishimoto et al. reference.

Appellant argues that the examiner has not identified the specific portion of the Bauer et al. reference relied upon for the teaching of "a bag used in a similar process which meets [Appellant's] claimed structure of the bag". Appellant states that appellants have reviewed the Bauer et al. reference in an effort to locate a teaching of a bag which meets appellant's claimed structure. While the first Office action did not recite the portion of the Bauer et al. reference relied on, the Final Office action points to the different figures, columns and lines where the Bauer et al. does in fact specifically point out the structure of a bag used in a similar process which meets the claimed structure of the bag. The rejection made in the first Office action is not considered to be in error for the fact that the columns, lines, and/or figures were not specifically pointed out. Further, it is noted that the appellant did not specifically respond to the particular rejection set in the first Office action. The examiner so stated in the Final Office action:

Finally, it is noted that appellant has not argued separately the dependent claims 23-43 nor has appellant challenged the examiner's position that it would have been obvious to substitute the old and well known bag of Bauer et al. for the old and well known bag of AAPA. Additionally, appellant has not argued or

challenged the examiner's various statements regarding the obviousness of the "melting point" language found in claim 22 or the other composition limitations found in the dependent claims as set forth in the previous Office action.

Appellant also failed to respond to the specific 103 rejection in the response After Final.

Appellant continues, pages 13-15 of the Brief, to criticize the Nishimoto et al. reference. Once again the Nishimoto et al. reference is not used in the rejection.

Appellant also argues again that none of the examples in Bauer et al. discloses a film having appellant's recited third layer which comprises polyester, not to mention the combination of appellant's recited third layer in combination with appellant's fourth layer, and that none of the films in the examples of Bauer et al. have any interior layer comprising polyester. Appellant then admits the Bauer et al. reference discloses that one or more of a wide variety of polymers can be present in various multilayer film constructions. Appellant then sets forth various passages from the Bauer et al. reference, and then states that Bauer et al. lists a very wide variety of polymers for the first, second, third, and fifth layers of the film, and states that polyester is not in any one or more of the listings of preferred polymers for any one or more of the first, second, third and fifth layers. The appellant then admits that when using hindsight based on appellant's teaching it is in fact possible to construct a film which meets the features of the film recited in the claim. The examiner points out that this is not a question of hindsight or one of picking and choosing. Rather it is a question of fact, i.e. are the recited elements found in the prior art reference applied. The mere fact that the reference may recite a wide variety of polymers and may not recite polyester as a

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preferred polymer is not at issue, and is not material to the question of whether or not the examiner has used hindsight to pick and choose from the recited polymers in the reference. Rather a review of the reference shows that a bag which meets the claimed structure is disclosed in the Bauer et al. reference. The following, taken from MPEP section 2131.02, supports the examiner's position and view:

A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED

A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). Id. at 1718. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and because the claim was anticipated, the unexpected properties were immaterial.).

Accordingly, as the structure of the bag is disclosed in the Bauer et al. reference that meets the limitations of the claim there is no question or issue that the examiner has made use of hindsight based on appellant's specification to arrive at appellant's claimed invention from AAPA in view of Bauer et al. Further, the question of whether

the Bauer et al. reference meets the language in question is not at issue based on the decisions cited in the above quoted section of the MPEP. Finally, while this section quoted from the MPEP may deal with anticipation under 35 USC 102, it is without question that 35 USC 103 rejections are predicated on 35 USC 102 for analysis..

Appellant has attempted to argue the 35 U.S.C. 103(a) rejection set forth in the Final Office action by arguing that there is no teaching or suggestion in the prior art to use the film in the stack sealing process recited in appellant's claims. In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the prior art (AAPA and Bauer et al.) teaches the claimed invention, and the Bauer et al. reference teaches why the film structure is especially suited for heat-shrinking bags for the packaging of meat products.

Furthermore, the bag structure recited in the claims does not effect the manipulative steps of the claims beyond it being provided. Also, if the method has been done with one old and well known bag structure, it is quite obvious to do the same method with any other type of bag structure, when as herein nothing new is expected or achieved beyond the old and well known bag structures.

Since, the bag structure is known in the prior art as evidenced by Bauer et al., and Bauer et al. discloses and teaches why one would use the bag in a heat-shrinkable bag process, it is quite evident that there is sufficient motivation and suggestion to combine the prior art (AAPA and Bauer et al.) to have arrived at the claimed invention.


Finally, it is noted that appellant has not argued separately the dependent claims 23-46 with regard to the 35 USC 103 rejection set forth in the Final Office action.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Stephen F. Gerrity
Primary Examiner

Conferees:

John Sipos

Louis Huynh